Remarks

Reconsideration and allowance of the subject patent application are respectfully requested.

The title of the application has been amended.

A clarifying amendment has been made to claim 38. In addition, claims 39-42 presented in the amendment dated May 27, 2003 have been re-numbered as claims 41-44, respectively, since claims 39 and 40 were previously presented by the amendment dated September 16, 2002. The amendments to claims 38-42 are made by way of clarification or to correct informalities and are not made for reasons relating to patentability.

Claims 25, 27-29, 31, 32, 34, 36-39 and 41-44 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Shiraishi *et al.* (U.S. Patent No. 4,981,296) in view of "CardBus" (Ikeya, "CardBus - The 32-bit PC Card Option") (hereinafter, "the CardBus document").

The example illustrative embodiments of the present application show, among other things, a hand-held display system such as a game machine to which different types of storage devices may be connected. In one aspect of the example illustrative embodiments, the storage device may have an attribute that can be used to set the clock speed of a processing system. For example, a storage device of a color game program may have attribute for setting the clock speed higher than that used for a monochrome game program in order to improve game processing. *See, e.g.,* page 14, lines 9-27 of the subject patent application. The storage device may also have an attribute that can be used to determine the compatibility of the storage device with the game machine. By way of example, not limitation, the application describes a "color-readiness code" that can be used to determine whether a storage device stores a color game program. *See, e.g.,* page 13, lines 4-12. The storage device may also be provided with a machine identification program for detecting the type of machine to which the storage device is connected. *See, e.g.,* page 9, lines 6-14.

As discussed in the prior responses, Shiraishi *et al.* discloses a data processing device in which an operator is able to change the data processing speed of a microprocessor (*i.e.*, either standard or slow speed) via a set-up menu. There is no

teaching or suggestion in Shiraishi *et al.* of a game program storage medium storing clock speed data as described in claims 25 and 27; or of a portable storage device storing video game instructions including a command for causing a microprocessor of a portable game machine to be set at one of a plurality of different speeds as described in claims 29 and 31; or of a storage device having a processing speed attribute as described in claims 34 and 36; or of a portable storage device having an attribute usable to set the clock speed of a video game machine as described in claim 41.

The office action alleges that because Shiraishi *et al.* teaches manually altering processing speeds

> one would have been motivated to include the correct processor speed with a specific game as it is obvious to automate a manual process. Therefore, it would have been obvious to one of ordinary skill in the art to modify the teaching Shiraishi (sic) and include processor speed configurations with a specific game to reduce the burden on a user of manually switching between processor speeds for a particular game.

First, even assuming for the sake of argument that one were for some reason motivated to automate the manual process of Shiraishi *et al.*, the office action improperly assumes that such automation would have been accomplished by including "processor speed configurations with a specific game." There is absolutely no showing in the office action that this would have been the case. Second, predicating the legal determination of obviousness on a generalized statement that "it is obvious to automate a manual process" improperly dispenses with the factual inquiry mandated by the Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1 (1966) and extensive precedent based thereon. It is for reasons like this that the Court of Appeals for the Federal Circuit has expressly rejected conclusory reliance on allegedly *per se* obviousness rules.

The office action continues by stating that "[a]dditionally, it is notorious (sic) well known that games and game system function can be duplicated in portable or console system format where a portable game system would include the claimed features of handheld game play, LCD display, and DMA operation." However, even assuming that a portable game system includes an LCD or DMA operation and that such features were provided to Shiraishi *et al.*, the subject matter of the rejected claims would still not result.

Independent claims 25, 29 and 34 also describe storing compatibility data in a storage or memory medium or in a storage device. Independent claim 41 calls for the portable storage device to have attributes usable by the video game machine to determine compatibility of the portable storage device and independent claim 43 calls for the portable storage device to have compatibility data. The compatibility feature is acknowledged in the office action to be lacking from Shiraishi *et al.* The office action alleges that the CardBus document remedies this deficiency. Specifically, the office action states "CardBus teaches a portable memory storage device for use in portable/desktop computers that stores compatibility data so that a determination can be made as to the interoperability between a host system and the memory device using device IDs..." It is Applicants' understanding that CardBus cards provide identification and configuration information through a Card Information Structure (CIS) (mentioned on page 2 of the CardBus document). However, Applicants fail to see the motivation for providing such a card for the device shown in Shiraishi *et al.* There are no compatibility issues identified in the context of the Shiraishi *et al.* device and thus there is no apparent reason to provide Shiraishi *et al.* with a portable memory storage device like that described in the CardBus document. Indeed, the office action simply states that "[i]n a memory embodiment, Cardbus **could** serve to hold any type of information, including game information (emphasis addded)." The mere possibility that the CardBus card could be used to hold game information is not evidence of the obviousness of doing so or of modifying Shiraishi *et al.* as proposed. There is simply no teaching or suggestion in the CardBus document of storing game information or of thereafter using such a card with the device of Shiraishi *et al.*

Independent claims 27, 31, 36, and 43 call for the storage device or memory medium to store a machine identification program for use in identifying the game machine with which the storage device or memory medium is used. There is no teaching or suggestion of this feature in Shiraishi *et al.* or in the CardBus document, nor does the office action address this feature.

For at least these reasons, Applicants respectfully submit that the rejection of claims 25, 27, 29, 31, 34, 36, 41 and 43 is improper and should be withdrawn.

Claims 28, 32, 37-39, 42 and 44 each depends from one of the independent claims discussed above. These claims are believed to be allowable because of this dependency and because of the additional patentable features recited therein. For example, claim 38 describes that during processing of the video game program, at least one processing operation of the processing circuitry occurs at a processing speed different than the processing speed set in accordance with the processing speed setting attribute of a storage device. There is no disclosure or suggestion of such a feature in either Shiraishi *et al.* or the CardBus document.

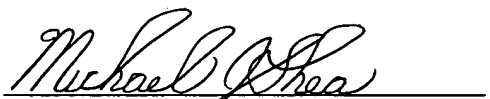
In view of the above-noted deficiencies of Shiraishi *et al.* and the CardBus document with respect to the independent claims, Applicants respectfully request reconsideration and withdrawal of the rejection of dependent claims 26, 30 and 35 as being obvious over the combination of these references in further view of Nagano *et al.* (U.S. Patent No. 5,556,108).

New claims 45 and 46 have been added. The subject matter of these new claims is fully supported by the original disclosure and no new matter is added. These claims are believed to be allowable over the applied references for reasons similar to those advanced above and for containing other patentable features not taught or suggested by the applied references.

The pending claims are believed to be in condition for allowance and early notification to that effect is respectfully requested.

Respectfully submitted,

NIXON & VANDERHYE P.C.



Michael J. Shea
Registration No. 34,725

1100 North Glebe Road, 8th Floor
Arlington, Virginia 22201
Telephone: (703) 816-4000
Facsimile: (703) 816-4100
MJS:mjs